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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,658	03/17/2004	Rodrick A. HERDMAN	EZL-001M	2657
26868 7590 12/11/2007 HASSE & NESBITT LLC 8837 CHAPEL SQUARE DRIVE SUITE C CINCINNATI, OH 45249			EXAMINER GALL, LLOYD A	
			ART UNIT 3673	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/708,658

**Applicant(s)**

HERDMAN, RODRICK A.

**Examiner**

Lloyd A. Gall

**Art Unit**

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6,9,11,12,22,23,44-55 and 57-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,9,11,12,22,23,44-55 and 57-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/17/04 and 1/9/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-4, 6, 9, 11, 12, 22, 23, 44-55 and 57-76 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 19-23 of copending Application No. 11/178,627. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-16 and 19-23 of the '627 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4, 6, 9, 11, 12, 22, 23, 44-55 and 57-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,290,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-20 of the '418 patent fully encompass the subject matter of the claims of the instant application.

Claims 1-4, 6, 9, 11, 12, 22, 23, 44-55 and 57-76 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 9-24 of copending Application No. 11/374,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because they

substantially claim the same subject matter, and claims 1-4 and 9-24 of the '299 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 9, 11, 12, 22, 45-52, 55, 58-60, 63-65, 68-72 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan (002) in view of the EP (124) reference.

Monahan teaches a lock including a housing 30, a plug 34, springs 49, drivers 44, pins 45, plural keys regarded as user keys of a set, a programming key and a master key with different (raised and lowered) contour edges received in the keyway passage 62, a change tool slot 52, a change tool 51, change members 47 moved by the change tool as seen in figure 14 after the plug is rotated. Monahan also teaches a shim defined by the topmost wafer 47 as seen in figure 12. With respect to paragraph "e)" of claim 6, for example, the lock of Monahan is capable of being reconfigured solely in response to a key, by removing the change tool such as in the figure 11 condition, and then inserting a key, rotating the key, and allowing a change member 47 to fall within the retainer cavity. As seen in figure 17, the EP (124) reference teaches using a ball (e) as a change member with a retainer cavity (f). It would have been obvious to substitute a ball in place of, or in addition to, the plural change member discs 47 of Monahan, in view of the teaching of the EP (124) reference, the motivation being to prevent jamming between the topmost disc 47 in the retainer cavity and the shear line in the figures 13 and 14 position of Monahan.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claim 22 above, and further in view of Smith (188).

In fig. 94, Smith teaches a shim 583 of a first diameter and a retainer cavity 545 of a second, smaller diameter. It would have been obvious to use a larger diameter shim with a retainer cavity of Monahan, in view of the teaching of Smith, the motivation being to control how many change members may enter a change cavity, in reprogramming a lock.

Claims 44, 57, 61, 62 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claims 1, 6, 60 and 72 above, and further in view of an additional teaching of the EP (124) reference.

As seen in fig. 17, the EP (124) reference also teaches drivers pins (b) larger than the opening of the retainer cavity (f). It would have been obvious to form the retainer cavity of Monahan smaller than the driver chambers for use with the change member balls of Monahan as modified by the EP (124) reference, in view of an additional teaching of the EP (124) reference, the motivation being to prevent jamming of the lock at the shear line by the drivers and the retainer cavity.

Claims 53, 54, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan in view of the EP (124) reference as applied to claims 1 and 60 above, and further in view of an additional teaching of Monahan and Smith. Monahan also teaches master shims defined by the topmost wafer 47 as seen in fig. 12. In fig. 94, Smith teaches a shim 583 of a first diameter and a retainer cavity 545 of a second, smaller diameter. It would have been obvious to use a larger diameter shim with a retainer cavity of Monahan, in view of the teaching of Smith, the motivation being

to control how many change members may enter a change cavity, in reprogramming a lock.

Applicant's arguments filed September 28, 2007 have been fully considered but they are not persuasive. In response to applicant's REMARKS on page 15, it is resubmitted that the double patenting rejections are appropriate. It is submitted that the REMARKS do not set forth how the claims of the instant application are patentably distinct from the claims of the applications and patent relied on in the double patenting rejections.

In response to applicant's remarks in the second full paragraph of page 16, it is submitted that the EP (124) secondary reference clearly suggests the combination of the references. In column 7 of the EP reference, paragraph [0026], the reference suggests that a ball, or a pin or disc, is usable as a tumbler movable into a retainer cavity. Accordingly, it is submitted that there is a suggestion in the references for combining their teachings. Further, one skilled in the lock art would be motivated to use a ball in a pin tumbler lock at the location of the shear line, since it is a well known principle in the lock art that using a ball at the shear line location prevents jamming of the lock, as clearly set forth in the USPN 3,183,692 to Check, at column 3, lines 53-63. The fact that the EP reference suggests that a ball or pin/disc is usable provides that there is a reasonable expectation of success in a lock such as that of Monahan. It is submitted both that the Monahan and EP references suggest the claimed invention, and the fact that using a ball at the shear line to prevent jamming of the lock is a well known principle in the lock art, presents a convincing line of reasoning as to why the artisan

would have found the claimed invention to have been obvious in light of the teachings of the prior art.

In response to the remarks on page 17, lines 11-12, it is submitted that the Monahan and EP reference need not suggest that their discs may cause jamming of their lock. It is inherent that the use of discs may cause jamming of a lock, just as it is inherent that the use of a ball at the shear line, by virtue of its rounded surface, would aid in preventing the jamming of a pin tumbler lock.

In response to the arguments on page 17, the last seven lines, the subject matter of figs. 16-20 of the EP reference represents prior art available to one of ordinary skill in the art.

In response to the argument on page 18, the fifth full paragraph, it is submitted that the embodiment of figs. 11-14 of Monahan would function effectively with a ball, just as is done with the lock of applicant.

The remarks on page 19, the first full paragraph are not clear as to what structure of applicant is being positively claimed, which is different from that of Monahan, as modified by the EP reference including a teaching of a ball. The remarks of page 19, the fourth full paragraph are not clear as to why the embodiment of figs. 11-14 of Monahan does not teach what is argued by applicant, and what structure is claimed that is not taught by the Monahan and EP references.

The remarks on page 20, the second full paragraph appear to argue against the Monahan reference individually, and the combination of the Monahan and Smith references does not appear to be addressed.



With respect to the last full paragraph of page 20, it is not clear what structure is being claimed that is not taught by the references. In response to the remarks on page 21, the first and second paragraph, applicant's change tool is within the lock during operation of the lock, as seen in fig. 11B, for example, and it is submitted that the references, as combined, teach the subject matter of claim 74.

The remarks on page 21, paragraph "G" are submitted as arguing against the Monahan reference individually. It is submitted that the references, as combined, teach the claimed limitations.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

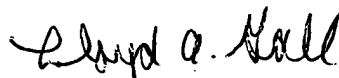
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lloyd A. Gall  
Primary Examiner  
Art Unit 3673

LG LG  
December 7, 2007